REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-13 are currently pending in the present application. Claims 1 and 13 are independent which have been amended through this Reply. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seek timely allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Taniguchi et al. (U.S. Patent No. 6,801,962)[hereinafter "Taniguchi"] and further in view of Shenoy et al. (U.S. Patent Publication No. 2003/0197887)[hereinafter "Shenoy"]. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

In this instance, neither Taniguchi nor Shenoy, alone or in combination teaches or suggests each and every claimed element. For example, independent claim 1 recites, *inter alia*,

> ***a code conversion means for converting the ID and the password into a code for authentication at a time of printing the image data by the recipient, wherein information on the ID and the password is encrypted into the code***;
>
> ***a code transmission means*** for ***transmitting the obtained code*** to the address inputted by the destination input means; and
>
> ***an image data returning means*** for, when the print terminal ***decodes the code to the ID and the password*** and ***transmits the ID and the password***, performing authentication using the ID and the password and, if a positive authentication result is obtained, reading the image data corresponding to the ID from the image data accumulation means and returning the read image data to the print terminal. (*Emphasis added.)*

Independent claim 13 recites the above-identified features as method steps. It is respectfully submitted that none of the applied prior art references, alone or in combination, teaches or suggests the above-identified claim features of independent claims 1 and 13.

Taniguchi merely discloses a conventional mail server system that includes a client 71 who creates image data, a server 72, a portable terminal device 73, and a plurality of output devices 74 provided on different sites, all of which are connected via a network. The network is connected, as a communication medium, with the client 71, the server 72, the output devices 74 and the portable terminal device 73 so that they are mutually accessible, thereby performing internal data communication in accordance with a predetermined communication protocol. (See col. 12, lines 13-29.)

The client 71 includes a mode to send the created image data to the server 72 and a mode to send an identification code (terminal ID) of the portable terminal device 73 that is carried by the user 79 who intends to notify the server 72 of information on the creation of the image data ("image data creation information", hereinafter). The portable terminal device 73 has a mode to search for the output device 74 to be used to output image data when receiving the image data creation information according to a predetermined criteria, a mode to select one output device 74 out of a plurality of the output devices 74 detected by the search, a mode to send a request for outputting the image data to the server 72, and a mode to send an identification code (output ID) of the selected output device 74 to the server 72. (See col. 12, line 57 – col. 13, line 3.)

Further, the server 72 has a mode to store the image data received from the client 71, a mode to notify the portable terminal device 73 designated by the client 71 of the image data

creation information and an identification code (server ID) of the server 72 itself, and a mode to send the image data to the selected output device 74 when receiving the output request from the portable terminal device 73. (See col. 13, lines 4-9.)

Conversely, the present invention teaches a printing service system and a printing service program in which a user who is unaccustomed to machine operations may print an image with ease (page 2, line 22). The printing service system includes ***a code conversion means*** for ***converting the ID and the password into a code authentication at a time of printing the image data by the recipient, wherein information on the ID and the password is encrypted into the code*** and a ***code transmission means*** for ***transmitting the obtained code*** to the address by the destination input means (page 3, line 21 – page 4, line 15). Further, when the print terminal decodes the code to the ID and the password and transmits the ID and password, performing authentication using the ID and the password, if a positive result is obtained the image data is read corresponding to the ID from the image data accumulation means and returns the image data to the prints terminal so that the user can print the image (page 3, line 21 – page 4, line 15). Under this structure, the user never has to remember their ID and password, they can simply use an encrypted code that is generated by the printing service system (page 4, lines 9- 15).

Taniguchi is distinguished from the claimed invention in that no where does Taniguchi teach or suggest a code conversion means (or step) and a code transmission means (or step) as recited in claim 1 (or claim 13).

It appears that the Examiner is relying on the server 72 as disclosing the claimed "***code conversion means***" for converting the user ID and the password into a code storing information on the ID and the password. It is respectfully submitted that the Examiner is misinterpreting the "sever 72" of Taniguchi. The server 72 of Taniguchi has three functions. The server 72 simply **i) stores** image data received from the client 71, **ii) notifies** the portable terminal device 73 designated by the client 71 of the image data creation information and an identification code (server ID) of the server 72 itself, and **iii) sends** the image data to the selected output device 74 when receiving the output request form the portable terminal device 73.

None of the above-noted three functions includes a step of converting a user ID and a password into a code storing information on the ID and the password. Claim 1 has been further amended to clarify that the code is required for ***authentication at a time of printing the image data by the recipient, wherein information on the ID and the password is encrypted into the code***. *Emphasis added.* Claim 13 has also been amended in a similar manner.

As demonstrated above, the user of the claimed invention never has to remember their ID and password, he/she can simply use an encrypted code that is generated by the printing service system. Conversely, user 71 of Taniguchi always has to provide the exact ID and password that is already stored in the server 72. For example, if user 71 of Taniguchi provides ***a code***, instead of the actual ID and password, as input data requested by the server, user 71 will never be allowed to access the network since the ***server 72 could not compare the code with the stored ID and password of user 71***. As demonstrated above, the server 72 only has three functionalities: storing, notifying, and sending. If the ID and password of user 71 is converted into a code, the server 72 will not recognize such code with the stored ID and password. Thus, user 71 of Taniguchi will be dined any access to the network system for print services.

In Taniguchi, there is simply ***no*** code conversion means that converts server ID and password into a code configured to authenticate a recipient at a time of printing the image. The identification code as disclosed by Taniguchi relates to server ID or image data ID. (See col. 13, lines 7 and 21.) Nowhere does Taniguchi teaches or suggests that the identification code includes ***both*** password and serve or image ID. Further, even if, *assuming arguendo*, the identification code of Taniguchi is considered to be the claimed code, this code has not been generated by converting the image data ID or server ID and password. As in the conventional prior art, Taniguchi requires both the ID and the password to be transmitted to the print server monitoring the plurality of output devices 74. Further, Taniguchi discloses that the identification codes are e-mail addresses or phone numbers. (See col. 13, lines 14-16.) Again, there is no teaching or suggestion in Taniguchi that the code includes both password and ID.

Therefore, for at least these reasons, it is respectfully submitted that Taniguchi fails to teach "***converting the ID and the password into a code authentication at a time of printing the***

image data by the recipient, wherein information on the ID and the password is encrypted into the code" as recited in claims 1 and 13. In addition, since Taniguchi fails to teach "a code conversion means (or step)", it is submitted that Taniguchi ***cannot*** teach "a code transmission means (or step) for transmitting the obtained code to the address inputted by the destination input means as recited in claims 1 and 13. At best, Taniguchi may only teach "an ID and password transmission means (or step)", ***not*** a code transmission means (or step), for comparing stored ID and password of a user.

Shenoy has not been, and indeed cannot be, relied upon to fulfill the deficiency of Taniguchi. Therefore, the asserted combination of Taniguchi and Shenoy (assuming these references may be combined, which Applicants do not admit) fails to establish a prima facie case of obviousness of any pending claim. Further, the Examiner relies on Shenoy to allege that Shenoy teaches a decoder to decode the code generated by Taniguchi's server 72. As demonstrated above in great detail, nether the server 72 nor any other features of Taniguchi teaches or suggest a "code conversion means (or step)" as recited in claims 1 and 13. Thus, even if Shenoy is combined with Taniguchi, there is no need to decode since no "code" has been generated by Taniguchi.

Therefore, for at least the reasons it is respectfully submitted that independent claims 1 and 13 are allowable over Taniguchi and Shenoy. Claims 2-12 are allowable at least by virtue of their dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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